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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/333,963	06/16/1999	NAOKI TAKAOKA	1982-0127P	4777
2292	7590	11/22/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			LAROSE, COLIN M	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/333,963	Applicant(s) TAKAOKA, NAOKI	
	Examiner Colin M. LaRose	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,8,11-13,16-18 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,8,11-13,16-18 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Arguments and Amendments

1. Applicants' amendments and arguments filed 16 September 2004, have been entered and made of record.

Response to Amendments and Arguments

2. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection established below.

Double Patenting

3. Applicant is advised that should claim 1 be found allowable, claim 23 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1, 3, 8, 11, 13, 16, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,828,461 by Kubo et al. ("Kubo") in view of U.S. Patent 5,049,929 by Anderson et al. ("Anderson") and U.S. Patent 6,006,279 by Hayes.

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Regarding claim 1, Kubo discloses an image processing apparatus (figure 1) for processing an image recorded on a recording medium, said image processing apparatus comprising:

an image reading device (elements 32, figure 1) for reading the image recorded on the recording medium as digital image data, subjecting the read digital image data to predetermined image processing (conversion portion 40, figure 2 subjects the image data to processing using a look-up table that was previously set (column 13, line 2)), and outputting processed image data (conversion portion 40, figure 2 outputs processed image data to memory 42 or correcting portion 44);

means for carrying out a necessary image processing on all of the image data read by the image reading device (conversion portion 40, figure 2 carries out necessary processing on all the data read by scanner 32);

means for carrying out a special image processing on the image data read by the image reading device, the special image processing being specially designated by an operator request (figure 4 is a user interface for allowing a user to use a cursor 60 to designate special processes (e.g. for specifying "size", "color tone", and "white margin") to be carried out by the CPU 14, figure 1); and

means for instructing the special image processing to be carried out by said special image processing means (mouse 24, figure 1 is means for the user to instruct the processes to be carried out).

Figure 10 of Kubo shows an example of a graphical user interface for instructing special processing to be carried out. Kubo teaches that special processes relating to the image's size, color tone, and white margin are selected via pull-down windows.

Figure 11A lists the special processes related to the size parameter. Similarly, figure 11B and 11C list the special processes related to the color tone and white margin, respectively. It is apparent that the special processes in each of the respective lists are mutually exclusive. For example, the margin cannot be both 2mm and 3mm, so only one margin size can logically be designated (figure 11C). Thus, any specified combination of margin sizes is an erroneous combination. The same is true for specifying both color tone processing and black-and-white processing (figure 11B) or any combination of the different size specifications (figure 11A). Selecting more than one process from any of the three lists in figure 11 is an erroneous special image processing combination. Since the processes in each of the lists are predetermined, any combination of intra-list processes is also predetermined to inherently be erroneous.

The only suitable combination of the special processes from the "size", "color tone", and "white margin" categories is a combination that consists of exactly one special process from each of the three categories. All other combinations that include more than one special process from any one category are predetermined to be unsuitable. Therefore, Kubo implicitly discloses predetermined combinations of special processes (i.e. a combination that includes more than one process from any one category) as being unsuitable but does not teach canceling an instructed special image processing combination if it is one of the predetermined combinations.

Kubo also does not appear to disclose that the system determines whether separate special image processes, when combined, should be allowed or disallowed, as claimed. As Kubo

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demonstrates, only special image processes of the same type (e.g. different “black and white” processes 106, figure 11B), when placed in combination, are considered for suitability. There appears to be no teaching in Kubo of how to handle the situation where separate special processes are combined and the suitability of that combination is to be determined.

Anderson discloses an image processing system that provides for conflict resolution among a plurality of user-specified commands. In particular, when a user specifies a combination of special processes to be carried out, Anderson’s system examines the suitability of such a combination. If any of the features or commands in the combination is mutually exclusive, then Anderson adopts a priority decision scheme – such as executing the most recent command – to handle the unsuitable combination. See column 4, lines 13-25.

Anderson essentially teaches that a user instructs a plurality of special processes to be executed in combination. If all the processes in the combination are suitable with respect to each other, then the combination is duly executed. However, if any of the processes are mutually exclusive, then the combination is cancelled, and a priority decision scheme is utilized to determine which processes should be executed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kubo by Anderson to enable Kubo’s system to resolve conflicts among special separate user-specified instructions automatically since Anderson’s decision scheme has the advantage of eliminating the need for an operator to manually deselect combined features that are mutually exclusive. The system is able to resolve conflicts automatically, so the “operator efficiency” is increased. See column 2, lines 39-52.

Kubo does not appear to disclose that the combination of special image processes includes at least two of the enumerated types of separate special image processes.

Hayes shows a screen shot (figure 4) of the well-known Adobe Photoshop software. In particular, figure 4 shows a picture being edited in a similar fashion as the image in figure 10 of Kubo. In both image editing GUIs of Kubo and Hayes, the user selects various special image processes that he would like to be performed on the image. However, Hayes shows a wider variety of image processes able to be performed, such as blurring, sharpening, and lens flare (LF) correction, wherein some of the operations, such as blurring and sharpening are mutually exclusive processes.

Kubo does not explicitly disclose his image-editing software is able to perform these types of special image processes or that it is able to prevent unsuitable combinations of these types of processes, however, it would have been obvious to include the aforementioned processes as selectable options since, as Hayes demonstrates, all three processes were conventional operations utilized in a GUI image-editing software, and including them in Kubo's system, which prevents unsuitable combinations per Anderson's teachings, would have provided more versatility in editing an image according to the user's desire.

Regarding claim 8, the modification to Kubo by Anderson teaches that a special image processing instructed last is given priority and a special image processing instructed first is cancelled (see Anderson, column 4, lines 12-19) when the predetermined combination of special image processings has been instructed by said instructing means.

Regarding claim 3, Kubo discloses special image processing means that includes an image structure effects for correcting the overall structure of an image, color reproduction effects for correcting the color tone of the image, and special effects for performing a variety of special processings (figure 4).

Regarding claims 11 and 13, figure 4 of Kubo provides a visual means (element 68) to notify the operator of the special image processings that have been instructed.

Regarding claims 16 and 18, Kubo discloses the use of a monitor (element 30, figure 1) that can display an image in a plurality of display states (elements 86-87, figure 8) and an instruction menu (element 84, figure 8) corresponding to image processings that is made to be valid only when the corresponding image is displayed on the monitor (column 21, lines 29-33). Thus, the image processings activated by the menu buttons must match the display state for any instructions to be considered valid.

Claim 23 is rejected for substantially the same reasons as set forth above for claim 1.

6. Claims 2, 4, 12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo in view of Anderson and Hayes, as applied to claim 1 above, and further in view of U.S. Patent 5,023,635 by Nealon.

Regarding claim 2, Kubo discloses an instructing means that gives instructions based on a user's manipulation of a mouse (element 24, figure 1) or a keyboard (element 22, figure 1).

Kubo is silent to a system in which a customer provides, to the instructing means, a recording medium containing order information.

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Nealon discloses a method by which a customer presents instructions in accordance with a recording medium, which contains encoded order information. "Customer comments and order instructions are recorded magnetically on the film" (column 7, lines 32-34), and the information is transmitted to an order entry station (column 7, lines 37-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kubo, Anderson, and Hayes by Nealon since inputting a recording medium containing order information to an instructing means is functionally equivalent to inputting order information by a mouse or a keyboard in that both methods accomplish the task of providing instructions.

Regarding claim 4, Kubo discloses special image processing means that includes an image structure effects for correcting the overall structure of an image, color reproduction effects for correcting the color tone of the image, and special effects for performing a variety of special processes (figure 4).

Regarding claim 12, figure 4 of Kubo provides a visual means (element 68) to notify the operator of the special image processings that have been instructed.

Regarding claim 17, Kubo discloses the use of a monitor (element 30, figure 1) that can display an image in a plurality of display states (elements 86-87, figure 8). As established for claim 1, an instructed special process is not valid when in a predetermined combination with another mutually exclusive process. Therefore, the instruction is considered valid when the selected contents of the image processing of the special image processing means instructed by the instructing means (i.e. the selected special processes) and the display state of the monitor (i.e. the visual indication of the contents to the use) do not match the predetermined combination.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Colin M. LaRose whose telephone number is (703) 306-3489. The examiner can normally be reached Monday through Thursday from 8:00 to 5:30. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au, can be reached on (703) 308-6604. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2600 Customer Service Office whose telephone number is (703) 306-0377.

CML

Group Art Unit 2623

19 November 2004

A handwritten signature in black ink, appearing to read 'Vikram Bali', with a large, stylized initial 'V'.

**VIKKRAM BALI
PRIMARY EXAMINER**